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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,865	10/20/2003	Che-Ming Teng	16127-002003	3339

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FISH & RICHARDSON PC  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/689,865

Applicant(s)

TENG ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-13, drawn to multiple uses employing piperazinediones that are **not** further fused at  $R_1, R^a$  or at  $R_1, R^b$ , classified in class 514, subclasses such as 253.01, 253.11, 255.02 and others as determined by the nature of heteroaryl or heterocyclos attached thereon.
- II. Claims 1-5, 7-11 and 13, drawn to multiple uses employing piperazinediones that are fused at either  $R_1, R^a$  or at  $R_1, R^b$ , classified in class 514, subclass 249 and others as determined by the exact ring system being formed.
- III. Claims 14-30, drawn to piperazinedione compounds that are **not** further fused at  $R_1$  with neighboring  $R_a, R_b, R_a',$  or  $R_b'$ , classified in class 544, subclasses 360, 364, 385 and others based on the nature of het rings attached thereon.
- IV. Claims 14-20, 22-28 and 30, drawn to piperazinedione compounds that are further fused at  $R_1$  with neighboring  $R_a, R_b, R_a',$  or  $R_b'$  groups, classified in class 544, subclasses such as 349, 350 and others based on ring system being formed.

The inventions are distinct, each from the other because of the following reasons:  
Compounds embraced in I/II and III/IV are drawn to separate cores in view of the ortho fusion permitted which would result in a multitude of different ring systems. In addition the compounds can vary widely at A and Z based on the presence of single or double bonds. Thus they are separately classified based at the very least on species particularly recited in the claims.

The compounds embraced in III/IV are not coextensive with those permitted in I/II but appear to be narrower in many aspects for the latter set and thus would require a separate electronic search and would be expected to raise different issues of patentability- at the very least based on the numerous "X" references cited in Search Report filed in parent which may be pertinent to compounds but not necessarily scope of methods claimed herein.

**If either I or II is elected applicants must elect a single use . In addition to an election of I-IV applicants must further elect a single species within the elected group for an initial examination.**

Based on species elected further restriction will be made at A and Z which has a different scope based on degree of unsaturation as well as the possibility of ortho fusion for II and IV.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Application/Control Number: 10/689,865  
Art Unit: 1624

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*E Bernhardt*  
Emily Bernhardt  
Primary Examiner  
Art Unit 1624